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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/667,851

09/22/2003

John Eugene Merkley JR.

16342D1-US

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7590

10/27/2008

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EXAMINER

LIVERSEDGE, JENNIFER L

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

10/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|---------------------------------------|--|
| Office Action Summary | Application No. 10/667,851 | Applicant(s) MERKLEY ET AL. | |
| | Examiner JENNIFER LIVERSEDGE | Art Unit 3692 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 10/667,851 filed on August 22, 2008.

The amendment contains original claims: 2-10, 12-20, 22-24 and 26.

The amendment contains amended claims: 1, 11, 21, 25 and 27.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 22, 2008 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 and 27 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175,

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184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). In the present case, claims 1-20 and 27 are directed towards a method but the method is only nominally tied to another statutory category. The claims refer to a data storage device and a data processing system. However, it is possible to read the claims such that the data storage device is a paper notebook and the data processing system is an individual using the notebook to perform the method steps. The 101 rejection could be overcome by incorporating positively another statutory category.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 7-9, 11-15, 17-19, 21-23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub No. 2001/0047307 A1 to Bennett et al. (further referred to as Bennett), in view of US Pub No. 2003/0163401 A1 to Dines et al. (further referred to as Dines) and further in view of Marketing Research 7th ed. by Aaker, Kumar and Day (further referred to as Aaker).

Regarding claims 1-2, 4-5, 7-9, 11-12, 14-15, 17-19, 21-23 and 25, Bennett discloses a method and system of facilitating an incentive program (pages 1-15), comprising the steps of:

Establishing a library as a comprehensive list of available incentive programs, the library stored in a data storage device associated with a data processing system (page 4, paragraphs 55-58; page 13, paragraph 137 and 143; page 14, paragraphs 145-154);

Selecting the available incentive programs from the library of incentive programs through the discretion of a particular retailer servicing a particular consumer (page 13, paragraphs 137 and 143; page 14, paragraphs 154);

Searching the library or its selected, available incentive programs to select a tailored list of candidate incentive programs from the library of available incentive programs (page 5, paragraph 66; page 6, paragraph 75-76; page 13, paragraphs 137 and 143; page 14, paragraphs 145-155);

Making information accessible on the available candidate incentive programs in the tailored list to the particular producer via an interface (page 4, paragraphs 55-58;

page 5, paragraph 66; page 6, paragraph 75-76; page 12, paragraph 131; page 13, paragraphs 137 and 143; page 14, paragraphs 145-155);

Supporting selection of a preferential one of the available candidate incentive programs to the particular producer via an interface (page 13, paragraphs 137 and 143; page 14, paragraphs 146, 152-155); and

Transferring incentive program data to a financial screening process [intended use - to reduce or eliminate duplicative reentry of the background data applicable to the incentive programs and the financial screening process associated with financing of the products] (page 2, paragraphs 17-18; page 3, paragraphs 40-43; page 4, paragraphs 55-57; page 8, paragraphs 88 and 95; page 10, paragraph 109; page 11, paragraph 124).

Bennett does not disclose receiving crop planning or background data of a particular producer and wherein the crop planning data is sent along with the incentive program to a financial screening process. However, Bennett discloses where informational data associated with the transaction may be sent with the incentive program data for financial screen (page 12, paragraph 127) and wherein financial is obtained based on the nature of the transaction (page 3, paragraphs 40-43) where a consumer can select products to be considered in the analysis of financial options. Dines discloses the offering of incentives and loans for agricultural related transactions (pages 1-5). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the incentive offering and financial screening as disclosed by Bennett to adapt the agricultural incentive offering and financial screening as disclosed

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by Dines. The motivation would be that a database of incentives can be developed to include incentives related to any product or service, and the same process steps of reviewing the database review for identifying a preferred incentive as disclosed by Bennett and Dines applies to any types of goods or services.

Neither Bennett nor Dines disclose selecting incentive programs based on retailer preferences comprising a geographic region that the retailer services, historic sales, and a supplier relationship with one or more suppliers of the incentive programs. However, Aaker discloses selecting marketing programs based on retailer preferences comprising a geographic region that the retailer services, historic sales, and a supplier relationship with one or more suppliers of the incentive programs (pages 689-693). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the providing of incentives and financial screening for various products as disclosed by the combination of Bennett and Dines to adapt the use of marketing techniques such as identifying a geographic area of interest, historic sales and supplier relationships as disclosed by Aaker. The motivation would be that Aaker describes basic marketing principles which are employed in various areas of business. Bennett discloses filtering loan offerings based on lender criteria and it would be obvious to include as lender criteria basic business principals such as where a lender intends to do business, data such as previous sales history with an individual or organization, and the relationships where have been established with individuals and organizations. This is part of basic business practice and it would be obvious to incorporate such parameters into the filtering as disclosed by Bennett.

Regarding claims 3, 13 and 26 Bennett does not disclose where the crop planning or background data comprises one or more of [the list as provided in the claim language]. However, Dines discloses where the crop planning or background data comprises one or more of [the list as provided in the claim language] (pages 1-5). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the information gathering for conducting a transaction as disclosed by Bennett to adapt the gathering of specific agricultural data as disclosed by Dines. The motivation would be to collect data relative to the transaction. While Bennett gathers data related to a product or service to be purchased as well as the individual desiring to make the purchase, the system would need to gather agricultural related data for offering incentives in the agricultural products and services.

Regarding claim 27, Bennett discloses returning the tailored list of the candidate incentive programs and potentially relevant incentive programs that would be applicable, but for a submitted query that fails to satisfy a minimum purchase or minimum transaction requirement (page 1, paragraphs 7-9).

Claims 6, 10, 16, 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett, Dines and Aaker, and further in view of Official Notice.

Regarding claims 6 and 16, neither Bennett, Dines nor Aaker disclose translating a brand name into a generic name for comparison to program data. However, Examiner takes Official Notice that it is old and well known and would be obvious to one of ordinary skill in the art at the time of the invention to translate a brand name to a generic name in order to search a database of incentives related to the product. Organizing a database by generic name rather than brand name offers a broader search mechanism, whereby products are identified by generic name rather than brand name. For example, if a system user were looking for incentives on facial tissue, the user would return more “hits” on incentives if the search were conducted on facial tissue rather than on Kleenex. If a user searched for incentives on Kleenex, then only returns for the brand name would be returned. However, if the user searched for incentives on facial tissue, then returns for Kleenex brand, Puffs brand, Angel soft brand, as well as store brands and/or lesser well known brands, etc.

Regarding claims 10 and 20, neither Bennett, Dines nor Aaker disclose formatting data to be interpretable by a financial application. However, Examiner takes Official Notice that it is old and well known and would be obvious to one of ordinary skill in the art at the time of the invention to format data to be interpretable by a financial application. Data sharing requires that data be in a format which provides for the data to be transferred and processed, otherwise the process of data transfer would be ineffective. Bennett discloses where data is shared amongst parties of a transaction, ranging from a buyer to a seller to parties providing financing, and where data is passed

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back and forth between each of these parties. Therefore, the data must be in a format that enables a buyer to enter personal data, a seller to offer goods for sale, a financier to offer incentives and financing packages and wherein each of the parties is able to communicate through sharing data in a format which enables that communication.

Regarding claim 24, neither Bennett, Dines nor Aaker specifically disclose providing system access after receiving an identifier and password from parties accessing the system. However, Examiner takes Official Notice that it is old and well known and would be obvious to one of ordinary skill in the art to incorporate the use of party identifiers and passwords with the online incentive and financing as disclosed by Bennett. Sensitive personal data related to individuals and their potential purchases is stored in the Bennett system. The users of the system range from buyers to sellers to financiers, where each has access to the system, and it is old and well known and would be obvious to one of ordinary skill in the art to require identifiers and passwords for granting such access in order to protect the sensitive data which has been gathered and stored by the Bennett system. Bennett discloses where each of the above mentioned parties may begin a transaction, evaluate options for purchases and associated financing, and place the transaction on hold for further consideration, returning later to complete the transaction. It would be obvious to require identifiers and passwords in order to establish the profile and store transaction data, in order to return to the transaction at a later point in time.

Response to Arguments

Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection. Newly added limitations have been addressed in the rejection above, and other arguments are addressed below.

Applicant argues that the combination of Bennett and Dines fails to disclose “available incentive programs selected from a comprehensive list of incentive programs through the discretion of a retailer” and “searching the library of available incentive programs” based on “received crop planning data or background data” to “select as tailored list of candidate incentive programs from the established library of available programs”. As detailed in the rejection above, Bennett discloses making available incentive programs, wherein those incentive programs are through the discretion of a retailer, specifically where Bennett discloses that particular retailers make incentives available, and that the incentives are provided through the discretion of a retailer and wherein those incentives can be further modified and changed by a retailer at their discretion in real time. Bennett further specifically discloses searching the library of incentives, as discussed above, where the incentives are searched, filtered, and presented to a user in a sorted manner for comparison and selection. The filtering is done based on background data received data from a user in order to provide a tailored list for such comparison and selection. As cited in the rejection above, Bennett discloses an incentive program based on received user inputs and Dines discloses the offering of incentives and loans for agricultural related transactions (pages 1-5). It would be obvious to one of ordinary skill in the art at the time of the invention to modify

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the incentive offering and financial screening as disclosed by Bennett to adapt the agricultural incentive offering and financial screening as disclosed by Dines. The motivation would be that a database of incentives can be developed to include incentives related to any product or service, and the same process steps of reviewing the database review for identifying a preferred incentive as disclosed by Bennett and Dines applies to any types of goods or services.

Applicant additionally argues that the combination of Bennett and Dines fails to disclose "a library of available incentive programs for agricultural input products targeted to producers of agricultural products", where the agricultural input products are non-financial products. Bennett discloses the making available in a library a listing of available incentives for goods and services. Bennett does not disclose specific products of goods and services for which the incentives apply. However, it would be obvious to one of ordinary skill in the art that goods and services can apply to any field of commerce. Additionally, Dines specifically discloses the use of incentives related to the agricultural industry and Dines states in paragraph 4 that "Before the growing season, many agricultural producers borrow money from a lending institution to pay expenses associated with producing the commodity. When the commodity is corn, for example, an agricultural producer may borrow money from a lending institution to pay expenses associated with planting and growing the corn." Therefore, the combination of Bennett and Dines discloses the providing of incentives for agricultural input products, where the inputs are non-financial.

Applicant finally argues that the combination of Bennett and Dines fails to disclose transferring the crop planning data and incentive program data on the preferential program to a financial screening process “to reduce or eliminate duplicative reentry of the background data applicable to the incentive programs and the financial screening process associated with financing of the products” as a newly added limitation in claims 1, 11 and 21. First, it is noted that the newly added claim limitation language represents “intended use” and that the system and method as disclosed by Bennett provides for the transferring of data received from a user and incentive program data to a financial screening process as detailed in the rejection above. The intent of the Bennett system is to provide a full service operation in which users can input various parameters, seek outputs related to incentive programs available, and to make a selection of an incentive program as well as completing required financing without leaving the system. Through the background of the invention (page 1), Bennett describes the shortcomings of the previously available systems in which conventional loan processing systems are utilized. Bennett offers the benefit of a more streamlined, real-time, and efficient system as provided for in the disclosure.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jennifer Liversedge/
Examiner, Art Unit 3692